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08/753, 929 12/10/96 ROTHECHILD

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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5733	DVORKA, L
ART UNIT	EXAMINER
5733	PAPER NUMBER
06/05/98	

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No. 08/753,929	Applicant(s) Rothschild et al
Examiner Linda C.M. Dvorak	Group Art Unit 3733



Responsive to communication(s) filed on Apr 27, 1998

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- Claim(s) 1-15 and 17-37 is/are pending in the application.
Of the above, claim(s) 6-8, 11, 12, 19-23, 25, 26, 32-34, 36, and 37 is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 1, 10, 13, 15, 17, 18, 24, 27-31, and 35 is/are rejected.
 Claim(s) 2-5, 9, and 14 is/are objected to.
 Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____.
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). 7
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 10, 15, 17, 18, 24, 27-31, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 10, 24, and 35, the phrase "below the malleoli posterior above tendon and curved centered" is indefinite because the meaning of "above tendon and curved centered" is unclear and requires clarification. This is a repeat rejection from the first Office action which was unaddressed in applicant's amendment of 4/27/98.

Regarding claims 15 and 28, the phrase "positioned depending upon the particular extremity support desired" is vague and indefinite and fails to define the metes and bounds of the instant invention.

Further regarding claim 15, lines 3 and 4 are redundant. The amended claim does not appear to be an accurate reproduction of the original claim.

The remaining claims are necessarily rejected as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 13, 15, 16, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason et al [4289122].

Mason et al discloses a method of forming a foot orthosis comprising the steps of forming a positive mold of the extremity; positioning a thermoformable plastic material around predetermined locations on the mold [note col. 3; ll. 32-35]; wrapping a thermoformable sheet around the mold and the thermoplastic material; and vacuum sealing the thermoplastic sheet around the mold so that the thermoplastic sheet and thermoplastic material combine together.

Note particularly figures 6-10.

Regarding claim 13, see col. 3, lines 37+.

Regarding claim 15, note orthosis 1 with reinforcing area 8.

Regarding claim 16, the two pieces are integrally formed.

Regarding claim 28, the area "8" is considered to be a "predetermined reinforcement location" as broadly as claimed.

Claims 15, 16, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason et al [4938777].

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Mason et al discloses a foot orthosis comprising a rigid support structure formed from a thermoplastic material [10] wherein the support is reinforced in predetermined areas with additional thermoplastic material [14].

Regarding claim 16, note col.4 , line 33.

Regarding claim 27, the mold is considered to be “modified” as broadly as claimed.

Regarding claim 28, the area “14” is considered to be a “predetermined reinforcement location” as broadly as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Allowable Subject Matter

Claims 2, 3, 4, 5, 9 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claims 10, 17, 18 and 29-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 4/27/98 have been fully considered with the following effect: Claims 2, 3, 4, 5, 9, 10, 14, 17, 18 and 29-31 have been indicated to contain allowable subject matter. The arguments with respect to the remaining claims have been considered but are not deemed to be persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of a copolymer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues the term integral. Initially , applicant should note that the term "integral" does not require a unitary one-piece structure. *In re Kohno*, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Further, applicant's arguments with respect to Mason et al ['122] having a first layer of cooled thermoformable material placed next to the positive mold *under* a stocking is irrelevant for two reasons; namely, nowhere is the temperature of the material being used claimed, and further, the recited method in

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no way precludes the use of the stocking between the layers; the two are still “integrally formed” as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication should be directed to Linda C. M. Dvorak at telephone number (703) 308-0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

LINDA C. M. DVORAK
EXAMINER
ART UNIT 3302

LCM Dvorak
June 4, 1998